

REMARKS

Rejection of Claims 1 – 21 and 23 – 24 under 35 U.S.C. § 103 (a) as being unpatentable over US Pub. No: US 2002/0078151A1 (Wickman et al.) in view of US Pat No: US006430604B1 (Ogle et al.), hereafter referred to as Wickman and Ogle.

Applicant respectfully traverses the rejection of claims 1 – 21 and 23 – 24. Reconsideration is respectfully requested.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action on page 3 states “[b]oth Wickman and Ogle teach designs for forwarding messages.” (col. 3, lines 5-20, Ogle). The Office Action also states on page 17, under “Response to Remarks” of the Office Action dated 02/06/2007, that “Ogle teaches how a message can be sent to more than one recipient to their respective (possibly different) devices (this is deemed equivalent to the claimed forwarding communication message to a particular next device, associated with a next user).” The Office Action specifically refers to “[a]nother object of the present invention is to provide this technique by enabling messages to be sent from instant messaging systems to users who are reachable through alternative delivery mechanisms, such that messages can be accepted for and delivered to a recipient even though he is not currently logged on to an IMS,” column 2, lines 46 - 52 of Ogle, as describing or being analogous to Applicant's claim “forwarding the communication message to a particular next device, associated with a next user, of the at least one next device of the forwarding list if the target device is unavailable for text messaging with the originating device.” This analogy is, however, a mischaracterization of Ogle, and Applicants respectfully disagree.

Applicant respectfully submits that the combination of Wickman and Ogle does not teach or suggest all the claim limitations as set forth in independent claims 1 and 17. Specifically, independent claims 1 and 17 require “forwarding the communication message to a particular next device, associated with a next user, of the at least one next device of the forwarding list if the target device is unavailable for text messaging with the originating device,” which are not taught or suggested in the combination of Wickman and Ogle.

Referring to Ogle, col. 3, lines 5 – 20 state that “... forwarding the message on a particular alternate delivery mechanism associated with the recipient when the determining has a negative result...” It is clear from this statement that the message to be sent to the recipient is forwarded on the particular alternate delivery mechanism associated with the recipient if the recipient is not logged on to the IMS. Hence, the message is forwarded on the particular alternate delivery mechanism of the same recipient and not alternate or next recipient. Therefore, Ogle does not describe “forwarding the communication message to a particular next device, associated with a next user,” i.e. next recipient, when a target user is not logged in, as required by Applicant’s invention.

In addition, Ogle in col. 11, lines 52 – 56 states that “[i]t may be desirable to allow messages to be delivered to multiple recipients, each of which may use a different alternative delivery mechanism.” Thus, it is clear from the statement that the message can be delivered to more than one target user (recipient) using a different alternative delivery mechanism. Each user may use a different delivery mechanism, but Ogle does not describe forwarding the message targeted for the target user to a next user if the target user is not logged in.

Referring to Wickman, page 5, para [0045] and [0046] state that “[a]n integrated voice response (IVR) function is also included in database 202, which offers at least one prerecorded message providing callers various options on directing their calls.” As an example, Wickman states that “..., Sue has her IVR 320 to offer callers the options of having the communication system poll Sue’s various communication devices in an attempt to find Sue....” Thus it is clear that Wickman does not describe “forwarding the communication message to a particular next device, associated with a next user.”

Therefore, the combination of Wickman and Ogle do not teach or suggest the claim limitation of “forwarding the communication message to a particular next device, associated with

a next user,” as required by independent claims 1 and 17, so the Applicant respectfully requests withdrawal of the rejection of independent claims 1 and 17 under 35 U.S.C 103.

For the above reasons, Applicant submits that independent claims 1 and 17 are not obvious in view of the combination of Wickman and Ogle, and therefore that the rejection of independent claims 1 and 17 under 35 USC 103(a) is improper and should be withdrawn. Applicant requests that claims 1 and 17 now be passed to allowance.

Dependent claims 2 – 16, and 18 – 21, 23 - 24 depend from, and include all the limitations of independent claims 1 and 17, which are shown to be allowable for the reasons given above. Therefore, Applicant respectfully submits that dependent claims 2 – 16, and 18 – 21, 23 - 24 are in proper condition for allowance and requests that claim 1 – 21 and 23 - 24 now be passed to allowance.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Such action is earnestly solicited by the Applicant. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact the Applicant’s attorney or agent at the telephone number indicated below.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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